

Serial No.: 09/873,222
Art Unit: 2623

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed December 29, 2005. Through this response, claims 1, 7, 9, and 11 have been amended and claim 10 has been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims are respectfully requested.

Cancellation of Claim

Claim 10 is canceled without prejudice, waiver, or disclaimer. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of the canceled claim in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

Claim Rejections - 35 U.S.C. § 102(e)

Claims 1 and 7 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Shiota et al.* ("*Shiota*," U.S. Pat. No. 6,324,521). Applicants respectfully traverse this rejection. Nevertheless to advance prosecution and facilitate early allowance of the claims, Applicants have amended claims 1 and 7 to incorporate the features/steps of dependent claim 10, which has not been rejected as allegedly anticipated by *Shiota*. Specifically, claim 1 has been amended to recite the feature of "means for enhancing the digital image automatically using an automatic digital image enhancement system." Claim 7 has been amended to recite the feature of "enhancing

Serial No.: 09/873,222

Art Unit: 2623

the digital image automatically using an automatic digital image enhancement system.” *Shiota* does not teach or suggest these features/steps.

Therefore, in the present case, not every feature of the claimed invention is represented in the *Shiota* reference. Due to the shortcomings of the *Shiota* reference described in the foregoing, Applicants respectfully assert that *Shiota* does not anticipate Applicants’ claims. Therefore, Applicants respectfully request that the rejection of claims 1 and 7 be withdrawn.

Claim Rejections 35 U.S.C. § 103(a)

A. Rejection of Claims

Claims 2-5, 7 (sic, 8), and 9-15 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Shiota* in view of *Echerer et al.* (“*Echerer*,” U.S. Pat. No. 5,384,862). Applicants respectfully traverse this rejection. In addition, claim 10 has been canceled, thus rendering rejection of this claim moot.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) Section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must

Serial No.: 09/873,222
Art Unit: 2623

be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the *Shiota* and *Echerer* references, even when combined, do not teach or suggest all of the features of at least the independent claims.

1. Claims 2-3, 8-9, and 11

Claims 2-3 depend from claim 1, which has been amended to recite the feature of "means for enhancing the digital image automatically using an automatic digital image enhancement system." Claims 8-9, and 11 depend from claim 7, which has been amended to recite the feature of "enhancing the digital image automatically using an automatic digital image enhancement system." *Shiota* combined *Echerer* with does not teach or suggest these features/steps.

Instead of indicating where these distinct steps/features are found in either of *Shiota* combined *Echerer* references, the Office Action simply states with respect to claim 10, "[w]ith regard to the image enhancements being automatic, *Shiota* is interpreted as performing the operation automatically at a remote location as discussed with regard to claims 3 and 5." However, in rejecting claims 3 and 5, the Office Action refers to *Shiota* at col. 3, lines 32-45 and col. 4, lines 55-64. Upon careful review of these sections of *Shiota*, Applicants can find no reference to "enhancing the digital image automatically," as recited in claims 1 and 7. The reason for this omission is clear: the *Shiota* / *Echerer* combination simply would not result in

Serial No.: 09/873,222
Art Unit: 2623

Applicants' claimed invention. Indeed, the only references to anything being "automatic" in *Shiota* is with respect to the following: "the order may be converted automatically into the predetermined format" (e.g., col. 2, lines 29-31), "print a mailing label automatically" (e.g., col. 9, lines 49-50), "automatically sending him/her [customer] an electronic mail" (e.g., col. 9, lines 52-53), and "an order file is automatically generated" (e.g., col. 10, line 52). None of these passages teach or suggest "enhancing the digital image automatically," as recited in claims 1 and 7.

Therefore, in the present case, not every feature of the claims 1 and 7 is represented in the combination of the *Shiota* and *Echerer* references. Due to the shortcomings of the *Shiota* reference described in the foregoing, Applicants respectfully assert that the *Shiota*/*Echerer* combination does not anticipate or render obvious Applicants' claims 1 and 7. Because independent claims 1 and 7 are allowable over *Shiota* in view of *Echerer*, dependent claims 2-3, 8, 9, and 11 are allowable as a matter of law for at least the reason that the dependent claims 2-3, 8, 9, and 11 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing allowability of these dependent claims, the dependent claims recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record. Hence, there are other reasons why the dependent claims are allowable.

2. Claims 4-5

Claim 4 recites "wherein the enhanced digital image packet includes an enhanced digital image and an enhancement description packet that describes the enhancements made for each of the digital images." This feature is not taught or

Serial No.: 09/873,222
Art Unit: 2623

suggested by the combination of *Shiota* and *Echerer*. As the Office admits, “*Shiota* does not expressly disclose means for transmitting an enhanced digital image packet to the customer, including the enhancements made to the image.” *Office Action* at 4, 7. Indeed, *Shiota* does not even mention the words “enhance” or “enhancement” anywhere in its disclosure. The Office therefore relies on col. 3, lines 1-11 and FIG. 2 of *Echerer* as allegedly providing this feature of claim 4. *See Office Action* at 5, 7. However, the passage relied on by the Office merely states that “[t]he image may be incorporated into a report along with the results of calculations done using the image.” *Echerer* at col. 3, lines 7-8 (emphasis added). Thus, the information transmitted with the image of *Echerer* is simply calculations performed using the image, not “an enhancement description packet,” as recited in claim 4.

In addition, the portion of the specification describing FIG. 2 states, “processing enhances the image displayed and extracts information from the image as a result of an interchange of instructions and responses between CPU and user.... A report is prepared using the information and the image together....” *Echerer* at col. 6, lines 28-30 and 33-34 (emphasis added). Thus, the information of *Echerer* described here is simply information extracted from the image, not “an enhancement description packet,” as recited in claim 4. It should be noted that *Echerer* deals with radiographic images, which are used “to ascertain information about the features of or within [a] body” and that “[t]ypically, an X-ray is evaluated by drawing lines on it with a pencil and ruler to determine the relationships among the various features it contains.” *Echerer* at col. 1, lines 28-30 and 33-34. The information, therefore, that *Echerer* refers to as being transmitted with the digital image is information of this type that can be obtained from the digital image, not information about how the digital image may have been enhanced.

Serial No.: 09/873,222

Art Unit: 2623

Therefore, in the present case, not every feature of the claim 4 is represented in the combination of the *Shiota* and *Echerer* references. Due to the shortcomings of the *Echerer* reference described in the foregoing, Applicants respectfully assert that the *Shiota/ Echerer* combination does not anticipate or render obvious Applicants' claim 4, and respectfully request that the rejection be withdrawn. Because independent claim 4 is allowable over *Shiota* in view of *Echerer*, dependent claim 5 is allowable as a matter of law for at least the reason that the dependent claim 5 contains all elements of its base claim.

3. Claims 12-15

Claim 12 recites "wherein the enhanced digital image packet includes an enhanced digital image and an enhancement description packet that describes the enhancements made for each of the digital images." For at least the reasons cited above with respect to independent claim 4, this feature is not taught or suggested by the combination of *Shiota* and *Echerer*. Due to the shortcomings of the *Echerer* reference described in the foregoing, Applicants respectfully assert that the *Shiota/ Echerer* combination does not anticipate or render obvious Applicants' claim 12, and respectfully request that the rejection be withdrawn. Because independent claim 12 is allowable over *Shiota* in view of *Echerer*, dependent claims 13-15 are allowable as a matter of law for at least the reason that the dependent claims 13-15 contain all elements of their base claim.

In addition to the above-described defects of the rejection, Applicants respectfully assert that the proposed combination is improper. It has been well established that teachings of references can be combined only if there is some

Serial No.: 09/873,222

Art Unit: 2623

suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). In particular, the suggestion to combine must be found in the art itself. Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the network photograph service system of *Shiota* with the radiographic image evaluation apparatus and method of *Echerer*. Applicants submit that these are two different arts and the combination of the references is improper. The field of radiographic image analysis is very different from that a photographic print service. One searching for solutions in the photographic print service field of *Shiota* would not look for solutions in art related to an apparatus and method of evaluating radiographic images, such as that of *Echerer*. Therefore, for at least this reason as well, Applicants believe that a *prima facie* for obviousness has not been made against Applicants' claims.

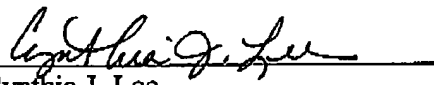
Therefore, it is respectfully submitted that each of these claims is patentable over *Shiota* in view of *Echerer* and that the rejection of these claims should be withdrawn.

Serial No.: 09/873,222
Art Unit: 2623

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


Cynthia J. Lee
Registration No. 46,033

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500